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18x 2/27/90

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
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NAPOLEONE FERRARA and DENIS GOSPODAROWICZ)
)
Serial No.: 346,165)
)
Filed: May 2, 1989)
)
For: ENDOTHELIAL CELL GROWTH FACTOR AND METHODS OF ISOLATION)

Group Art Unit: 186

Examiner: S. Guest

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on April 6, 1990.

Howard M Peters
Howard M. Peters (Reg. No. 29,202)

RESPONSE TO A RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Sir:

Applicants have received the restriction requirement dated February 1, 1990 and have reviewed it carefully.

The Examiner argues that:

> Restriction to one of the following inventions is required under 35 U.S.C. 121:
>
> I. Claims 1-5, 12-25, 33-36, and 38-40, drawn to a growth factor, an in vitro method of using, and methods of producing, classified in Class 350, subclasses 397 and 399.

II. Claims 6-11, 30-32 and 37,6Xdrawn to in vivo methods of using a phamaceutical composition, classified in Class 530, subclasses 397 and 399; and Class 514, subclasses 8, 12 and 21.

III. Claims 26-29, drawn to a process of producing the growth factor, classified in Class 530, subclass 397.

The Examiner's position is that:

Inventions I and II are related as product (the growth factor) and process of use (in vivo methods of using). The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using the product (MPEP 806.05(h). In the instant case the product as claimed can be used in a materially different process such as for in vitro use in cell culture media.

Inventions I and II are related as mutually exclusive species in intermediate-final (growth factor-pharmaceutical composition) product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful other than to make the final product (MPEP section 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP section 806.04(h)).

In the instant case, the intermediate product is deemed to be useful as a growth factor for use in compositions such as cell culture media and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process such as by automated synthesis.

A telephone call was made to Howard Peters on January 26, 1990 to request an oral election to the above restriction requirement, but did not result in an election being made.

In the preliminary examination of the claim, there appear to be duplicate claims. Claim 21 appears to be the same as claim 1, and Claim 36 appears to be the same as claim 15. In order to expedite examination, it would be beneficial for the applicant to clarify the apparent discrepancies in these claims in the response to the above restriction requirement.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Applicants respectfully traverse this restriction.

Applicants believe that these three classes of classes of inventions can be searched by the U.S.P.T.O. Examiner without undue hardship or burden and all three groups I, II and III can issue in a single U.S. application. The separate inventions of the Examiner are part of the same inventive concept. The public good is not served by issuance of multiple patents from this application.

However, to advance the prosecution of this application, Applicants' elect Group I, with traverse, for examination.

If the Examiner has any questions, please call the undersigned at 415-421-2674.

Respectfully submitted,

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Enclosure:
Petition for Extension of Time (1-month)